

## **REMARKS**

Pursuant to 37 CFR § 1.114, Applicants submit the following amendment and remarks in addition to the fee set forth in 37 CFR § 1.17(e). Claims 1-19 were previously examined. Claims 1-19 were rejected. Claims 1, 3, 13 and 16 are amended. Support for the amendments can be found in, for example, paragraph [0028] of the Application. Accordingly, no new matter has been added.

Reconsideration of the pending claims is respectfully requested in view of the above amendments and following remarks.

Applicant expresses her appreciation for the telephonic interview conducted on December 5, 2006 between the attorney for Applicant and the Examiner after issuance of the Final Office Action. During that communication, the Examiner requested that Applicant clarify the function of the needle and/or needle assembly in the independent claims. Attorney for Applicant suggested adding a limitation regarding the “electrical signal” in independent claims 1 and 16, as the Examiner noted in the Final Office Action that “the claim language in said claims do not describe any electrical signal to justify applicant’s arguments.” (Final Office Action, p.3) The attorney for Applicant pointed out that claims 3 and 13 already include this limitation, to which the Examiner pointed out that his objection was directed to independent claim 1.

### **I. Claims Rejected Under 35 U.S.C. § 103**

#### **A.**

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubota* in view of *Seo* or *Cory et al.* and in further view of U.S. Patent No. 4,825,711 to Jensen et al. (*Jensen*), U.S. Patent No. 3,979,835 to Sumption et al. (“*Sumption I*”) or U.S. Patent No. 4,071,957 to Sumption et al. (“*Sumption II*”). In order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (2) there must be a reasonable expectation of success; and (3) the references when combined must teach or suggest all of the claim limitations. MPEP § 2142. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

More particularly, the cited references do not teach or suggest all of the claim limitations of independent claims 1, 3, 13 or 16.

Independent claim 1 includes the limitations of (i) “a **conductive** component *slidably movable* from a first position to a second position” and (ii) “*an electrical signal to generate when the conductive component is in the second position*, wherein a movement corresponds to a depth of tissue penetration, *the depth of tissue penetration corresponding to a specific location within the tissue for delivery of a treatment agent.*” (App., claim 1)

Independent claim 3 includes the limitations of (i) “a first **conductive** component . . . [and] a second **conductive** component . . . the second conductive component arranged to generate an electrical signal *upon contact* with the first conductive element” and (ii) “*the second conductive component arranged to generate an electrical signal upon contact with the first conductive component*” and (iii) “*the depth of tissue penetration corresponding to a specific location within the tissue for delivery of a treatment agent.*” (App., claim 3)

Independent claim 13 includes the limitations of (i) “a first **conductive** component . . . [and] a second **conductive** component . . . the second conductive component arranged to generate an electrical signal *upon contact* with the first conductive element” and (ii) “*the second conductive element arranged to generate an electrical signal upon contact with the first conductive element, wherein the needle is adapted to deliver a treatment agent to a specific location within the intravascular tissue wall.*” (App., claim 13)

Independent claim 16 includes the limitations of (i) “a first **conductive** element . . . [and] a second **conductive** component . . . wherein a resistive force in response to the penetration allows the first conductive element to slidably move toward the second conductive element” and (ii) “*the second conductive element arranged to generate an electrical signal upon contact with the first conductive element*” and (iii) “*delivering a treatment agent to a specific location within the intravascular tissue wall.*” (App., claim 16) As stated in the Response to Office Action dated November 2, 2005, *Kubota, Seo and Cory* teach or suggest stationary pressure sensing mechanisms, not moveable pressure sensing mechanisms.

*Jensen* describes a probe unit for automatic determination of quality properties in meat. (Abstract) The probe includes gaskets 8 and 9 which are not described as conductive and which

therefore cannot produce an electrical signal when in contact. (col. 3, lns. 45-46) In fact, according to *Jensen*, the piston rod of the probe produces electrical pulses due to “the rotation of the toothed wheel in engagement with the rack 17.” (col. 4, lns. 50-53) Both *Sumption I* and *Sumption II* (collectively, *Sumption*) describe an apparatus for measuring carcasses. (Abstract) Applicant cannot discern anywhere in *Sumption* either (a) a conductive component slidably movable from a first position to a second position or (b) first or second conductive components slidably movable relative to each other, as taught in independent claims 1, 3, 13 and 16. In fact, according to *Sumption*, the slide means 58a is moved manually: “The tool is gripped by the handle 54 in one hand and the slide means 58a is gripped with the other hand and slid from the shown position to the position 58a’ shown in dashed lines . . . [w]hen the skin stops the penetration, slide element 58a is released, and the spring 60 returns the slide element 58a to an intermediate position between solid and dashed lines.” (col. 8, lns. 22-31) An “intermediate position” does not suggest any contact between two components. In contrast, controlled movement of the needle according to claims 1, 3, 13 and 16 is determined by (a) a conductive component slidably movable from a first position to a second position or (b) first or second conductive components slidably movable relative to each other.

B.

Additionally, Applicant submits that the cited references of *Jensen* and *Sumption* are non-analogous art. A prior art reference is analogous if (1) the reference is in the field of applicant’s endeavor or, (2) the reference is reasonably pertinent to the particular problem with which the inventor was concerned. Independent claims 1, 3 and 13 include the limitation of “an intravascular delivery device.” (App., claims 1, 3, 13) Independent claim 16 includes the limitation of “penetrating an intravascular wall.” (App., claim 16) Accordingly, the field of Applicant’s endeavor concerns medical devices and treatments using medical devices. On the other hand, both *Jensen* and *Sumption* are concerned with meat carcass probes and methods for measuring carcasses. The field of *Jensen* and *Sumption*’s endeavor therefore concerns meat processes. Moreover, the problem addressed in Applicant’s invention is the delivery of appropriate fluid to the tissue wall. (see, e.g., App., ¶ [0051]) On the other hand, the problem addressed in *Jensen* is to provide a probe unit which lends itself to be mounted in an automatic measuring apparatus which can perform the measurements on the supplied carcasses necessary to

determine the quality properties of these without assistance from an operator. (col. 1, Ins. 44-19). The problem addressed in *Sumption* is to provide an improved means and method for measuring carcasses in a continuous manner. (col. 3, Ins. 5-6) Neither *Jensen* nor *Sumption* are reasonably pertinent to the problem of delivery of appropriate fluid to a tissue wall. Accordingly, *Jensen* and *Sumption* are non-analogous art.

Claims 2 and 12 are dependent on independent claim 1 and therefore include all of the limitations of claim 1. Claims 4-11 are dependent on independent claim 3 and therefore include all of the limitations of claim 3. Claims 14-15 are dependent on independent claim 13 and therefore include all of the limitations of claim 13. Claims 17-19 are dependent on independent claim 16 and therefore include all of the limitations of claim 16. Applicant respectfully submits that independent claims 1, 3, 13 and 16 and their respective dependent claims are allowable over the cited references.




### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-19, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 500-4787.

Respectfully submitted,

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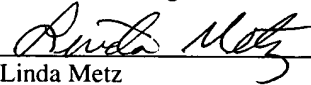
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